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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,604	03/28/2002	Miruka Ishii	09812.0439	5812
22852 7590 10/15/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER TRAN, HAI	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 10/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/980,604

**Applicant(s)**

ISHII ET AL.

**Examiner**

HAI TRAN

**Art Unit**

3694

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 13, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3.5-7.9-13, 15-19, 21-23, 26-30, 32, 33, 126 and 127 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3.5-7.9-13, 15-19, 21-23, 26-30, 32, 33, 126 and 127 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2008 has been entered.
2. This is the communication in response to the Applicant's Amendments/Remarks filed on July 8, 2008, for application, titled: "Investment System and Data Transmitting/Receiving Method".
3. Applicant has amended claims 1, 19 and 21. Accordingly, claims 1, 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126, and 127 remain pending in this application and have been examined.

***Priority***

4. This application is a 371 of PCT/JP01/01692, filed March 5, 2001 and claims the benefit of foreign applications JAPAN P2000-081859, filed March 17, 2000; JAPAN P2000-115772, filed April 11, 2000; and JAPAN P2000-301398, filed September 29, 2000.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for storing, transmitting and receiving investment data, does not reasonably provide enablement for the newly added step or limitation of "receiving at the server device a request to sell a second quantity of the investment ticket from the first investor to a different second investor". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The Examiner searched the entire specification and did not identify any description that supports this limitation or step.
7. Applicant is requested to cite the specific description in the specification and/or drawing(s) in order to support this limitation.
8. Claims 3, 5-7, 9-13, 15-18, 21-23, 26-30, 32, 33, 126, and 127 are also rejected because of their dependency on claims and 19.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126, and 127 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 19 recites a first step of "storing investment target data of an investment target in a server device" is unclear where the data is transmitted from and how the data is transmitted (via internet?). It is not clear if the data is transmitted from a user, investor (first, second, etc.) The metes and bounds of the claim cannot be understood because of the lack of definiteness in the claim.

12. Claims 21-23, 26-30, 32, 33, 126, and 127 are also rejected because of their dependency on claim 19.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1, 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126 and 127 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 19, 21-23, 26-30, and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al. (U.S. Patent No. 6,144,745) ("Akiyama") in view of Massey, Jr. (U.S. Patent No. 6,792,411) ("Massey") and further in view of Walker et al. (U.S. Patent No. 5,794,207).

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

16. **With respect to claim 19**, Akiyama teaches a data transmitting/receiving method comprising:

storing investment target data of an investment target in a server device (see Akiyama, col. 4, lines 20-61, figure 5/element 23);

transmitting by the server device, price data of an investment ticket of the investment target data and the investment target data to a terminal device (see Akiyama, col. 11, lines 19-41 of col.12, figures 18, 19);

receiving investment data for the investment target data from the terminal device (see Akiyama, col. 11, lines 19-41 of col.12, figures 18, 19), the investment data including a first quantity of the investment ticket to be purchased by a first investor (see Walker, Abstract "buyer"); and

receiving, at the server device, a request to sell a second quantity of the investment ticket from the first investor to a different second investor (see Walker, Abstract "seller"),

wherein the investment ticket is a financial instrument with monetary value, the monetary value depending on a performance of the investment ticket (see Massey, col. 1, lines 20-29, col. 2, lines 54-62).

Akiyama teaches a method and apparatus for transmitting and retaining data on recording medium, but does not explicitly teach financial instrument with monetary value. Massey teaches a method for funding the production of a movie by allowing interested potential viewers of the movie to purchase a share of the production company's stock (investment ticket) prior to production of the movie. Akiyama and Massey together are silent on "investment ticket to be purchased by the first investor and investment ticket to sell to a second investor when received a request at the server device". Walker teaches a method/apparatus allows a buyer of goods and services (first investor) to communicate on a commercial network system (request at the server device) a binding contract (second quantity of the investment ticket to) to a seller (a different second investor). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Akiyama and Massey together with the teachings of Walker to offer an improved system and method that allows managing, purchasing and requesting of buying/selling the investment tickets.

17. **With respect to claim 21**, Akiyama teaches the data transmitting/receiving method as claimed in claim 19, further comprising:

accumulating the first quantity of the investment ticket (see Walker, Abstract “buyer to communicate a binding contract on a commercial network system”, and Akiyama, col. 4, lines 11-19); and

transmitting notification data comprising at least one of the price of the investment ticket, the total number of investment tickets, and the number of investors to another terminal device when the resultant total number of tickets exceeds a predetermined value (see Massey, col. 7, lines 1-14, figure 3). One of ordinary skill in the art would have combined the teachings of Akiyama, Massey and Walker to offer an improved system and method that allows users to manage, purchase and request of buying/selling investment tickets.

18. **With respect to claim 22**, Akiyama teaches the data transmitting/receiving method as claimed in claim 19, further comprising:

receiving the investment target data from another terminal device (see Akiyama, col. 11, lines 19-41 of col.12, figures 18, 19); and

accumulating the investment target data transmitted from the another terminal device into the server device (see Akiyama, col. 4, lines 11-19). One of ordinary skill in the art would have combined the teachings of Akiyama, Massey and Walker to offer an improved system and method that allows users to manage, purchase and request of buying/selling investment tickets.

19. **With respect to claim 23**, Akiyama teaches the data transmitting/receiving method as claimed in claim 19, further comprising:



transmitting the investment target data to the terminal device in response to a request signal from the terminal device (see Akiyama, col. 11, lines 19-41 of col.12, figures 18, 19);

counting a number of transmission times of the investment target data (see Akiyama, col. 5, lines 12-36, figure 6); and

accounting to a user who receives the investment target data when the number of transmission times exceeds a predetermined value (see Akiyama, col. 5, lines 12-36, figure 6);

wherein the server device no longer accepts the investment data when the number of transmission times of the investment target data exceeds the predetermined value (see Akiyama, col. 5, lines 12-36, figure 6).

20. **With respect to claims 26-30**, Akiyama teaches the data transmitting/receiving method as claimed in claim 19, further comprising setting a retaining rate transmitted from another terminal device as the retaining rate of an investment ticket issuer of the investment target data (see Akiyama, figures 1-6, 9-21 and description), determining the retaining rate in accordance with size of the issuer (see Massey, col. 2, lines 59-62 where it says "number of tickets sold"), with the achievement of the investment target data (see Massey, col. 2, lines 54-62 where it says "number of tickets sold is sufficient to the cost of making the movie"), with a popularity vote (see Massey, col. 6, lines 46-67, figure 3), and setting the retaining rate of an investment ticket issuer of the investment target data at 30% to 51% (see Massey, col. 7, lines 1-6 where it says "based on an extrapolation of the rate of sale of the stock").

21. Although Massey does not explicitly teach the 30% to 51% retaining rate, it teaches the extrapolation technique which is a method to extrapolate a data from a curve. It may require a little tweaking to get the extrapolation to the right percentage, but the Examiner believes that a combination of the Akiyama, Massey and Walker would have disclosed the claimed features within the individual claims. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Akiyama and Massey together with the teachings of Walker to offer an improved system and method that allows managing, purchasing and requesting of buying/selling the investment tickets.

22. **With respect to claim 127**, Akiyama teaches the data transmitting/receiving method as claimed in claim 19, but does not explicitly teach investment dividend feature. However, Massey teaches that wherein the investment ticket provides rights for receiving a dividend, and wherein a dividend value of the dividend depends on the performance of the investment target (see Massey, col. 4, lines 17-26). One of ordinary skill in the art would have combined the teachings of Akiyama, Massey and Walker to offer an improved system and method that allows users to manage, purchase and request of buying/selling investment tickets.

23. Claims 32-33 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Akiyama in view of Massey and Walker and further in view of Tagawa et al. (U.S. Patent No. 6,834,348) ("Tagawa").

24. **With respect to claims 32-33**, Akiyama, Massey and Walker disclose the data transmitting/receiving method as claimed in claim 19, but do not explicitly teach the floating, lower and higher prices in the purchasing order. However, Tagawa teaches that wherein when selling and buying of investment tickets of the investment target data is carried out between investors, the server device causes a transaction to be made at a floating price (see Tagawa, Figure 5, col. 11, lines 52-62), and wherein when selling and buying of investment tickets of the investment target data is carried out between investors, the server device causes a transaction to be made in the order of lower prices in the selling order and in the order of higher prices in the purchasing order (see Tagawa, at least figures 3 and 5, col. 11, lines 31-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Akiyama, Massey and Walker together with the teachings of Tagawa to offer an improved system and method that allows managing, purchasing and requesting of buying/selling the investment tickets.

25. **With respect to claims 1, 3, 5-7, 9-13, 15-18, and 126**, these claims include the necessary processors and components for implementing the method claims 19, 21-23, 26-30, 32, 33, and 127 and have the same steps and limitations. Hence, they are rejected under the same rationale provided in claims 19, 21-23, 26-30, 32, 33 and 127.

***Conclusion***

26. Claims 1, 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126, and 127 are rejected.
27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.
28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./  
Examiner, Art Unit 3694

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694